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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/217,878	12/21/1998	GREGORY SCOTT DUNCAN	VTN-415	3825

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EXAMINER

SIPOS, JOHN

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 05/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/217,878

Applicant(s)

DUNCAN ET AL.

Examiner

John Sipos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-46 is/are pending in the application.
- 4a) Of the above claim(s) 37-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 26-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 18.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

RESTRICTION

Applicant's argument regarding the restriction requirement have been considered but are not persuasive. Claims 37-46 of Group II are directed to an invention that is independent or distinct from the invention set forth in the claims of Group I. Applicant argues that the Examiner has erred in stating that the claims of Group are directed to the forming of single containers while the claims of Group II are directed to forming a plurality of containers. This argument is not correct with respect to the claims as they were set forth prior to the amendment after Final rejection. Although the current amendment directs both groups of claims toward the packaging of a set of packages, this relationship does not prevent a restriction requirement.

The two groups of inventions are directed to different machines: one is shown in Figure 1 and the second in Figure 5. These two machines are considered to be independent inventions that cannot be used in the same machine. Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects are independent (See MPEP 806.04). The Group II claims are directed to an apparatus comprising a single platen for a plurality of carriers/containers and a plurality of mandrels operating on the plurality of carriers while the Group I claims are directed to a plurality of platens each carrying a single carrier/container and a plurality of mandrels each operating on a single carrier. Furthermore, the Group II structure provides independent operation of the plural mandrels by using lifts on each of the mandrel. This is not part of the Group I machine where the lifts drive the plural platens. The two machines consists of different parts and operate differently.

The restriction is considered to be proper and made Final.

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REJECTIONS OF CLAIMS BASED ON FORMAL MATTERS

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

- (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.
- (b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.
- (c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 as failing to adequately teach how to make and use the invention, i.e. failing to provide an enabling disclosure. (A rejection of claims based on this objection follows this paragraph.) The disclosure does not disclose the combination of different parts of the two embodiments in a single machine as claimed in claim 36. Claim 26 is directed to multiple platens with multiple lower lifts while claim 36 is directed to multiple mandrels with multiple upper lifts. This combination in a single machine is not set forth in the specification.

Claim 36 is rejected under 35 U.S.C. ' 112, first paragraph, as being predicated on an **insufficient disclosure** for the reasons set forth in the objection to the specification set forth above.

REJECTIONS OF CLAIMS BASED ON PRIOR ART

Claims 26-30 and 36 are rejected under **35 U.S.C.103(a)** as being unpatentable over the patent to Kuethe (5,155,969 – cited by applicant). The Kuethe device comprises a plurality of carriers (16) carrying containers (25), a plurality of vertically moveable lifts (68,70,72 and 74), a plurality of platens (52,54,56,58) one on each of the lifts, a plurality of mandrels (44,46,48,50) above the platens and a lidstock maneuvering system (30+) for placing a lidstock sheet between the containers on the carriers and the mandrels which seal the lidstock to the containers to form a set of packages. The packages are subsequently separated after leaving the machine. The main difference between the machine of Kuethe and the claimed invention is the number of containers on each platen. The Kuethe devices uses two containers 25 and 26 on each platen but it would have been obvious to one of ordinary skilled in the art to use one or any number of containers since the number is merely a matter of design consideration and duplication of parts. Furthermore, the number of containers being operated on is merely a matter of experimentation to develop the optimum and most efficient machine operation. Regarding the number of mandrels used, it is well known in the art to use a single mandrel to seal a plurality of containers if individual control of the sealing operation is not necessary or desired. It therefore would have been obvious to one of ordinary skilled in the art to use a single mandrel in the Kuethe machine to seal a plurality of containers. The specific product being packages is given little patentable significance in apparatus claims since it does not affect the structure of the device.

Claims 31-35 are rejected under **35 U.S.C.103(a)** as being unpatentable over the patent to Kuethe in view of Edwards (5,565,059 – cited by applicant) or Edwards (5,528,878). The patent to Kuethe does not specifically teach the inspection of the packages. The patents to Edwards shows a contact lens packaging system wherein an inspection system verifies the proper alignment of the printed matter on the lidstock within the machine (see column 8, lines 30-36 and column 10, line 1, respectively). It would have been obvious to one skilled in the art to provide the packaging a system of Kuethe with an inspection system such as disclosed by Edwards to ensure proper registration of the lidstock with the containers.

Claims 26-36 are rejected under **35 U.S.C.103(a)** as being unpatentable over the patent to Ciba Geigy(WO 98/32587) – cited by applicant). The Ciba device comprises a plurality of carriers (1) carrying containers (3), a plurality of vertically moveable lifts (61), a plurality of platens (top portions of 61) one on each of the lifts, a plurality of mandrels (70) above the platens and a lidstock maneuvering system for placing a lidstock sheet between the containers on the carriers and the mandrels which seal the lidstock to the containers to form a set of packages. The main difference between the machine of Ciba and the claimed invention is the number of containers on each platen. The Ciba devices uses more than one container on each platen but it would have been obvious to one of ordinary skilled in the art to use one or any number of containers since the number is merely a matter of design consideration and duplication of parts. Furthermore, the number of containers being operated on is merely a matter of experimentation to develop the optimum and most efficient machine operation Regarding the number of mandrels used, it is well known in the art to use a single mandrel to seal a plurality of containers if individual control of the sealing operation is not necessary or desired. It therefore would have

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been obvious to one of ordinary skilled in the art to use a single mandrel in the Ciba machine to seal a plurality of containers.

Claims 26-28,35 and 36 are rejected under **35 U.S.C. 102(b)** as being clearly anticipated by Giovannone (5,379,572) in view of Kuethe. The patent to Giovannone shows a packaging machine which comprises a plurality of carriers (read on the portion of the conveyor holding/pushing each blister), a plurality of vertically moveable lifts 22,32,42, a plurality of platens 26,36,46 on the lifts, a plurality of mandrels 20,30,40 above the platens and a lidstock maneuvering system 16 for placing lidstock between the blisters on the carriers and the mandrels which seal the lidstock to the blisters. It would have been obvious to one of ordinary skilled in the art to provide the lidstock of Giovannone in a continuous sheet form that is subsequently cut to any size as shown by Kuethe to ease the positioning of the lidstock in the sealing mechanism. The specific product being packages is given little patentable significance in apparatus claims since it does not affect the structure of the device.

Claims 29-34 are rejected under **35 U.S.C.103(a)** as being unpatentable over the patent to Giovannone in view of Kuethe (as applied above) and further in view of Edwards (5,565,059 – cited by applicant) or Edwards (5,528,878). The patent to Kuethe does not specifically teach the inspection of the packages. The patents to Edwards shows a contact lens packaging system wherein an inspection system verifies the proper alignment of the printed matter on the lidstock within the machine (see column 8, lines 30-36 and column 10, line 1, respectively). It would have been obvious to one skilled in the art to provide the packaging a system of Kuethe with an inspection system such as disclosed by Edwards to ensure proper registration of the lidstock with the containers.

RESPONSE TO APPLICANT'S ARGUMENTS

Applicant's arguments with respect to the claims have been considered but are moot in view of the new rejections.


The patent to Edwards (5626000) shows in Figure 10 a single mandrel for multiple containers and Shannon (5524419) shows the sealing of a plurality of contact lens containers with a continuous sheet to form a group of closed containers that are subsequently separated.

Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **(703) 308-1882**. The examiner can normally be reached from 6:30 AM to 5:00 PM Tuesday through Friday.

The **FAX** number for Group 3700 of the Patent and Trademark Office is **(703) 305-3579**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703) 308-2187

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-1148.


John Sipos
Primary Examiner
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